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In re Application of: Hadden

Serial No.: 09/837,076

Group Art Unit: 3623

Filed: 4/18/2001

Confirmation No.: 8330

Examiner: Tarae

For: **PERFORMANCE-BASED TRAINING ASSESSMENT**

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Sir:

### Appeal Brief

This Appeal Brief is being transmitted in this application with respect to the Notice of Appeal filed on 20 January 2006 and the Notice of Non-Compliance mailed June 8, 2006. Our check for \$250 for the small entity Appeal Brief fee was submitted previously. Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account 501923.

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## **APPELLANT'S BRIEF**

### **1. Real Party in Interest**

The real party in interest in this appeal is the assignee of all rights to the disclosed invention, Capital Analytics, Inc.

### **2. Related Appeals and Interferences**

There are no appeals or interferences that will directly affect or be directly affected by, or have a bearing on the Board's decision in this appeal.

### **3. Status of the Claims**

Claims 4, 6-9 and 31 remain in the case. The rejections of claims 4, 6-9 and 31 are subject to appeal.

### **4. Status of the Amendments**

An amendment after the final Office Action was submitted and has been entered.

## **5. Summary of Claimed Subject Matter**

### **5.1 Overall Disclosure of the Claims**

As claimed in independent Claim 31, the method includes steps performed by a computer including defining a role (page 2, lines 15-22, paragraph 0006) having a measurable performance (page 5, paragraph 0024 and 0025, Figure 1B) and a separately measurable skill in which an improvement of the skill at least plausibly improves the performance (page 7, line 28 through page 8, line 2, paragraph 0030). The claim language makes a distinction between "performance" and "skill" and highlights the fact that they are separately measurable. Further, the claim points out the relationship between the skill and the performance, in that an improvement in the skill, at least plausibly, improves the performance.

This relationship will be clear from the following example. Consider the role of a wide receiver on a professional football team. The performance of a wide receiver can be measured in a statistic such as the number of touchdown catches per game. Various skills that the wide receiver may have may contribute to catching touchdown passes. One such skill is speed, such as may be measured by the individual's time to run a 40-yard dash. Other skills may also go into the overall performance of a wide receiver's ability to catch touchdowns per game, such as having "good hands;" footwork to enable separation from a defender, or the like.

At least plausibly, the speedier the individual is at the 40-yard dash, the higher his touchdown catches per game statistic will be. The 40-yard dash skill and the touchdown catches per game performance are independently measurable. The skill is measured by the time it takes the individual to run 40 yards; the performance is a total or average of touchdown catches per game. At least plausibly, improvements in the skill (time in the 40-yard dash) will improve the

performance (touchdown catches per game). But, we don't know for sure, and this invention helps determine if that "plausible" relation is correct or not.

As recited further in Claim 31, once an individual is associated with the role, the individual's skill level is measured (page 7, lines 7-27, paragraphs 0028 through 0029) and the individual's performance is measured to achieve a first actual performance metric. Using our example, a particular hypothetical individual can run a 40-yard dash in 5 seconds, and his performance metric is 0.8 touchdown catches per game. The occurrence of an event may be training or another event expected to assist the individual to run faster (page 7, line 30 through page 8, line 2, paragraph 0030).

Then, the performance of the person after that training can be re-measured (page 8, line 3 through line 10, paragraph 0031), and the improvement in the skill can also be re-assessed, using those separate measures. That is, if the individual now runs a 40-yard dash in 4.5 seconds, that would be a measurable improvement in the skill of running a 40-yard dash. A determination of the individual's metric of caught touchdown passes per game is independently measurable. That might increase to 0.9 touchdown passes per game. Or, it might stay the same, or perhaps even drop. The invention provides, as claimed in Claim 31, a method for analyzing a relationship between the first and second performance metric (change in the touchdown catches per game) and the skill (change in the 40-yard dash time) of the individual before and after the event occurrence on a computer (page 8, line 11 through page 9, line 7, paragraphs 0032 through 0034). From that, a determination can be made whether the training or other event occurrence increased the performance of the individual (touchdown catches per game), based at least partially on their relationship between the first and second actual performance metrics and the skill (40-yard dash time) of the individual.

### **5.2 Comparisons between individuals – Claim 8**

Claim 8 includes the recitations of Claim 31 and specifies that the event occurrence is a training event bearing on the actual skill level of the individual. The method includes measuring performance metrics for the performance of a second individual before and after the training event, although the second individual is not subjected to the training event. The method includes comparing the first and second performance metrics of the second individual with the performance metrics of the first individual to determine effectiveness of the training event on the actual skill level (page 9, lines 8-26, paragraph 0035).

### **5.3 Influence other than the training event – Claim 9**

Claim 9 depends on claim 8, which in turn is dependent on claim 31. The method includes identifying an increase between the first and second actual performance metrics of the first individual and the second individual; and indicating an influence other than the training event causing the increase between the first and second actual performance metrics of the individual and the second individual (page 25, line 28 through page 26, line 13, paragraphs 0067 and 0068).

## **6. Grounds of Rejection to be Reviewed on Appeal**

### **6.1. All claims make up a first group.**

All of the rejected claims are properly viewed as first group. These claims were rejected as unpatentable under 35 U.S.C. 103 over U.S. Patent No 6,157,808 to Hollingsworth.

### **6.2. Comparisons between individuals – Claim 8.**

Claim 8 is separately patentable. These claims were rejected as unpatentable under 35 U.S.C. 103 over U.S. Patent No 6,157,808 to Hollingsworth.

### **6.3. Influence other than the training event – Claim 9.**

Claim 9 is separately patentable. These claims were rejected as unpatentable under 35 U.S.C. 103 over U.S. Patent No 6,157,808 to Hollingsworth.

## 7. Arguments

### 7.1 All Claims

A fundamental problem with the Hollingsworth reference is the fact that it does not teach or disclose a measurable performance and a separately measurable skill. Recall the example of the football wide receiver. The measured performance is touchdown catches per game. The measured skill is speed. Does increasing the wide receiver's speed increase his touchdown catching ability? Plausibly, yes. Do we know that reliably? No. Applicant's invention deals finding out how reliable that guesstimate is – Hollingsworth does not.

Hollingsworth solely deals with the measurement of skills or tasks. To the extent that any conclusions about an employee's job performance are made, they are derived from measurements of the task or skills, not separately measured. Applying Hollingsworth to our wide receiver, we would test his speed in the 40 yard dash; any increase in speed would be said to make him a better wide receiver, never looking at his touchdown catches.

Page 3 of the Final Office Action said Hollingsworth discloses defining a role having a measurable performance and a separately measurable skill in which an improvement of a skill at least plausibly measured improves the performance, citing column 3, line 65 through column 4, line 5 and column 5, lines 26-42 and lines 60-62 of Hollingsworth. Nothing in those passages talks about a measurable performance. There are conclusory statements about performance, but they are all derived from measurements of the employee's mastery of a skill or tasks (which are the equivalent of skills). There is nothing in Hollingsworth that teaches measuring the performance separately from measuring the skill.

The Advisory Action points to Column 7 lines 20-36 of Hollingsworth, which discuss certifications as being the separately measurable performances. But, this passage of

Hollingsworth says certifications represent collected skills that comprise skill sets that are important to successful job performance. Thus, the certifications are not separate measurements from the skills -- they are collections or lists of skills. The statement that they are “important” to job performance is an unproven assumption. It is like saying we know that increasing a wide receiver’s speed will increase his number of his touchdown catches per game, without proving it!

Continuing with our wide receiver example, let’s say the team sends him to wide receiver training camp, where the camp coaches worked on his 40 yard dash, agility drills and weight training directed to strengthening his hands. The Camp Coaches give him a certificate of completion that indeed his 40 yard dash speed was increased, his ability to run an obstacle course increased, and his hand strength increased 10%. But, they did not determine if he can catch more or less touchdown passes per game. Yes, he earned his certificate (and using the Hollingsworth invention, we can make a record of that certificate in a database), but we still don’t know if his touchdown catching performance has increased.

At the top of page 4, the Office Action refers to Hollingsworth Job Performance Measure (JPM) as maintaining a job performance measure for each employee. However, the job performance table does not separately measure performances. It is only a collection of skills or assessments of the employee’s ability to function at higher cognitive, psychomotor or affective level. See column 9, lines 49-52. There is no mention of measuring a job performance separately from any of these elements. The Advisory Action widens the citation to lines 49-57 of column 9, but those additional lines don’t tell us anything relating to applicant’s invention.

The Hollingsworth reference from time to time refers to “enabling objectives,” but those are not the separately measurable job performance of applicant’s invention. The enabling objectives are described by Hollingsworth as specific skills or hybridized skill statements (see



columns 6, line 66 through column 7, line 1). Again, these are derived from skill measurements, not separately measured.

Since Hollingsworth never separately measures performance, the remainder of claim 31 cannot be read on (or near) Hollingsworth. Claim 31 includes “before the occurrence of an event that may increase a skill level of the individual, measuring the individual's skill to determine a skill level and measuring the individual's performance as a first actual performance metric.” Hollingsworth never suggests such a thing. Claim 31 also includes “after the occurrence of an event, assessing the individual's performance as a second actual performance metric,” but Hollingsworth does not measure the performance as defined in applicant’s claim, after an event.

Claim 31 also recites “analyzing a relationship between the first and second actual performance metrics and the skill of the individual before and after the event occurrence on a computer.” Hollingsworth does not do this.

Finally, Claim 31 recites “determining whether the event occurrence increased the performance of the individual based at least partially on the relationship between the first and second actual performance metrics and the skill of the individual.” Again, this is not disclosed in Hollingsworth. The claimed measurements are not available in Hollingsworth, so that any relationship between them cannot be analyzed. Nor can any conclusions about how events affect skills and performance be made using Hollingsworth. **Applicant’s invention is way beyond where Hollingsworth takes the art.** Accordingly, Hollingsworth does not anticipate applicant’s claims, contrary to the position asserted by the Examiner.

Nor does Hollingsworth suggest or provide a motivation to make the invention applicant has claimed. Hollingsworth merely discloses certain elements that are in applicant’s claim, namely measuring skills and storing the skill measurements. The Examiner alleges that they

may be used in the present invention, without stating a motivation that Hollingsworth provides to one of ordinary skill in the art to combine those elements or to add to them from undisclosed elements. A lawful holding of obviousness based on a combination of references requires some teaching or suggestion in the references that would lead one skilled in the art to combine the references in a way that would result in the applicant's claimed invention. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against **the subtle but powerful attraction of a hindsight-based** obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." (emphasis added)). As stated in *In Re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000): "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed".)

## **7.2. Comparisons between individuals – claims 8**

The rejections of claim 8 as being directed to an invention that would have been obvious from the Hollingsworth patent are even further afield. The Examiner acknowledges that Hollingsworth does not disclose measuring first and second actual performance metrics of individuals where one individual is subject to training and another is not. Yet, apparently guided by hindsight from applicant's disclosure, the Examiner asserts that it would have been obvious to do so.... and then follow this non-disclosed and unsuggested step with a further unsuggested step of comparing the first and second actual performance metric of the second individual with a first and second actual performance metrics of the individual to determine the effectiveness of the training of that on the actual skill level.

Perhaps the Examiner's use of hindsight is most clearly shown in the statement:

“[f]urthermore, since the exams are designed to specifically assess employee skill levels (column 12, lines 6-9), comparing exam results between trained and non-trained employees would provide very targeted information relating to the effectiveness of the training and thus, aid in the improvement/enhancement of the training provided to employees...” (final rejection at page 7)

Hollingsworth says nothing like that – the Examiner is using applicant's disclosure against applicant, which *Dembiczak* says not to do.

Also, Applicant is claiming a system in which the measurable performance and separately measurable skill are measured. By merely reiterating that comparison of the skills of two people is made, the Examiner's comments highlight the fact that a separately measured performance is not in Hollingsworth.

### **7.3. Influence other than the training event: Claim 9**

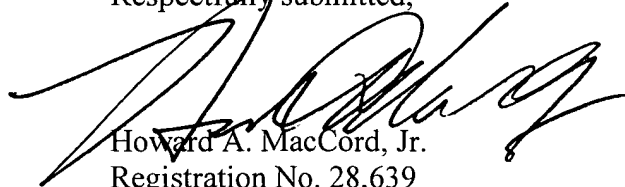
Claim 9 depends on claim 8, which in turn is dependent on claim 31. Claim 9 includes identifying an increase between the first and second actual performance metrics of the individual and the second individual, and indicating an influence other than the training event causing the increase between the first and second actual performance metrics of the individual and the second individual.

The explanation of the rejection of claim 9 again acknowledges that measuring the performance metric is foreign to Hollingsworth. The reference to Hollingsworth's disclosure of maintaining information related to the performance of tasks, such as duty area, activity type, procedures, standards, etc. is not anything close to the performance metrics of applicant's claims. Perhaps guided by hindsight, one might use some of the collected information of the

Hollingsworth system in a system such as applicant's, but Hollingsworth itself does not do that -- nor does it suggest doing that.

The rejections should be reversed and the claims should be allowed.

Respectfully submitted,



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## **8. Claims Appendix**

The appealed claims are as follows:

4. (Previously Presented) The method of Claim 31 further comprising:  
analyzing a difference between a required skill level for the role and the measured skill level of the individual; and  
determining if training is necessary to raise the skill level to the required skill level.
6. (Previously Presented) The method of Claim 31 further comprising:  
comparing the measured skill levels of the individual before and after the event occurrence; and  
correlating any difference between the measured skill levels of the individual before and after the event occurrence with the ability of the individual to carry out the defined performance.
7. (Previously Presented) The method of Claim 31 further comprising:  
comparing the measured skill level of the individual before and after the event occurrence with the first and second actual performance metrics; and  
determining a result of changes in the measured skill level of the individual before and after the event occurrence on the ability of the individual to carry out the defined performance.
8. (Previously Presented) The method of Claim 31 wherein the event occurrence is a training event bearing on the actual skill level of the individual and further comprising:  
measuring a first actual performance metric for the performance of a second individual before the training event;

measuring a second actual performance metric for the performance of the second individual after the training event, wherein the second individual is not subjected to the training event; and

comparing the first and second actual performance metrics of the second individual with the first and second actual performance metrics of the individual to determine effectiveness of the training event on the actual skill level.

9. (Previously Presented) The method of Claim 8 further comprising:

identifying an increase between the first and second actual performance metrics of the individual and the second individual; and

indicating an influence other than the training event causing the increase between the first and second actual performance metrics of the individual and the second individual.

31. (Previously Presented) A method comprising steps performed by a computer including

defining a role having a measurable performance and a separately measurable skill, in which an improvement of the skill at least plausibly improves the performance;

associating an individual with the role;

before the occurrence of an event that may increase a skill level of the individual, measuring the individual's skill to determine a skill level and measuring the individual's performance as a first actual performance metric;

after the occurrence of an event, assessing the individual's performance as a second actual performance metric;

analyzing a relationship between the first and second actual performance metrics and the

skill of the individual before and after the event occurrence on a computer; and  
determining whether the event occurrence increased the performance of the individual  
based at least partially on the relationship between the first and second actual performance  
metrics and the skill of the individual.

### **9. Evidence Appendix**

These references were cited by the Examiner in making rejections, and applicant relies on portion of them to show the errors of the rejections. Copies are attached.

<b>Patent Number</b>	<b>1<sup>st</sup> Named Inventor</b>	<b>Examiner Cited in Office Action Dated</b>
U.S. Patent No 6,157,808	Hollingsworth	September 23, 2005



## **10. Related Proceedings Appendix**

None.